

REMARKS

Applicants thank the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119, and receipt of a certified copy of the priority document in this Application's parent, 09/962,344, which is now abandoned.

Applicants thank the Examiner for considering most of the references cited with the Information Disclosure Statement filed October 23, 2003. However, the Examiner indicates in the instant Action that "a copy of JP 6-81347 was not found," and therefore has not initialed this reference as considered on the PTO-1449 form appended to the instant Action.

Applicants respectfully submit that JP 6-81347 was of record in this Application's parent, 09/962,344, and therefore Applicants are not required to submit another copy in this Application. Nevertheless, to assist the Examiner and speed prosecution, Applicants include herewith a copy of JP 6-81347.

Applicants respectfully request the Examiner to consider JP 6-81347 and return another copy of the PTO-1449 Form included in the October 23, 2003 Information Disclosure Statement indicating that JP 6-81347 has been considered.

Applicants thank the Examiner for indicating that the Formal Drawings filed October 23, 2003 are accepted.

Status of the Application

Claims 1-19 are all the claims pending in the Application, as claims 2-19 are hereby added to more fully define the current invention. Claim 1 has been rejected.

Indefiniteness Rejection

The Examiner has rejected claim 1 as being indefinite under 35 U.S.C. § 112, second paragraph. The Examiner alleges (O.A., pg. 2) that:

Claim 1 is a single claim which claims both an apparatus (a resin molding die) and the method steps of using the apparatus (a resin filled around each of said magnets for fixedly securing said magnets to said flywheel) is indefinite.

Applicants respectfully disagree.

Claim 1 recites the structural features of “a magneto-generator rotor and a resin molding die.” The “magneto-generator” comprises the structural features of a “bowl-shaped flywheel,” a “plurality of magnets,” and “resin filled around” the magnets. The “resin molding die” comprises the structural features of “an outer peripheral surface” and “projections.”

The portion of claim 1 cited by the Examiner as reciting “method steps of using the apparatus,” (“resin filled around each of said magnets”) is not a method or process step. This portion of claim 1 indicates that a resin is part of the claimed “magneto-generator rotor,” not a step of adding such resin. “Filled around” the magnets simply describes the physical location of the resin.

Thus, it is clear that there are no “method steps of using the apparatus” recited in independent claim 1, and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 101 Rejections

The Examiner has rejected claim 1 under 35 U.S.C. § 101, alleging that the claim “is directed neither to a ‘process’ or a ‘machine,’ but rather embraces or overlaps two different statutory classes of invention” (O.A., pg. 3).

Applicants respectfully disagree, for at least the reasons discussed above with respect to the 35 U.S.C. § 112 rejection. More specifically, both the recited “magneto-generator” and “resin molding die” are classifiable together in a single statutory category (*e.g.*, “machine” or “manufacture”). Further, claim 1 does not include process or method steps, as explained above.

Thus, withdrawal of the rejection is respectfully requested.

Obviousness Rejection

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Shiga et al.* (US 5,907,206; hereinafter “*Shiga*”) in view of *Odazima et al.* (US 4,137,884; hereinafter “*Odazima*”). This rejection is respectfully traversed.

The Applied References

Shiga discloses a rotor 1 (see FIG. 1) with magnets 2, holder portion 6 and resin molded member 8 retaining magnets 2 to holder portion 6. The rotor 1 is formed (see FIGS. 4A and 4B) by an injection molding process where magnets 2 are arranged in recesses 11 of mold 10, holder 6 is arranged near the magnets 2, and resin 8 is injected into the voids between these features.

In contrast to the injection molding process disclosed in *Shiga*, *Odazima* discloses a magneto with flywheel 1 (see FIG. 1) and magnets 4 held in place by a radially outward resilient force provided by ring shaped holder 5. The magneto is assembled by inserting magnets 4 and holder 5 into flywheel 1, and then dipping the assembly in an adhesive varnish while magnets 4 are held in place by holder 5 (col. 2, line 50 - col 3, line 16).

Thus, it is easy to see that *Shiga* and *Odazima* are directed to radically different, and mutually exclusive, methods for constructing a magneto/rotor.

The Examiner's Position

The Examiner takes the position that *Shiga* discloses almost all of the features of claim 1, but fails to teach or suggest “the projections provided in said outer peripheral surface abutting against and retaining said plurality of said magnets (2) in a circumferential direction at predetermined positions.” Applicants agree that *Shiga* is deficient at least with respect to these features.

In an attempt to show that such “projections” are known, the Examiner applies *Odazima*, taking the position that it discloses “a magneto generator wherein the ring-shape magnet element holder 5 (Fig. 5) [has] projections (5a) provided in the outer peripheral surface of the ring.”

The Examiner alleges that one of skill in the art at the time of the invention would have been motivated to modify *Shiga* in view of *Odazima* because the references “are in the same field of endeavor, [and] the purpose disclosed by [*Odazima*] would have been recognized in the pertinent art of [*Shiga*].”

There Would Have Been No Motivation To Modify Shiga In View Of Odazima

Applicants respectfully submit that one of skill in the art at the time of the invention would not have been motivated to modify *Shiga* in view of *Odazima* as the Examiner has alleged.

First, it has long been held that the Examiner must “show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453 (Fed.Cir. 1998).

Here, the Examiner has failed to cite even one specific reason why one of skill would have modified the manufacturing process of *Shiga* to somehow incorporate the ring shaped magnet holder 5 of *Odazima*. Rather, the Examiner merely alleges that the references are “in the same field of endeavor.”

Notwithstanding the Examiner’s position, it is clear that the only similarity between *Shiga* and *Odazima* is that both disclose a product that functions as a rotor. However, the structures of the rotor 1 of *Shiga* and the magneto of *Odazima* (and the respective processes used to form these products) are quite different.

Specifically, *Shiga* discloses a system where magnets 2 are affixed to holder portion 6 by a resin 8 that is injection molded around these features (*i.e.*, rotor 1 is constructed by an insert molding process). In contrast, *Odazima* discloses a system where magnets 4 are affixed to holder portion by the mechanical action of ring holder 5 (and a coating of an adhesive varnish). *Odazima* is not related to any injection molding process or the use of any resin to hold its magnets 4, nor does it indicate that ring holder 5 could be usable in any such processes.

In fact, there would simply be no reason to add the features of ring holder 5 (or any portion thereof) of *Odazima* to the mold 10 of *Shiga*, as *Shiga* already provides recesses 11 in mold 10 to hold and align magnets 2 prior to the injection of resin 8. Thus, one of ordinary skill would not have looked to the tongues 5a of ring holder 5 of *Odazima* to provide alignment of magnets 2, as that function is already provided in *Shiga*.

Thus, Applicants respectfully submit that independent claim 1 is patentable over the applied references, and respectfully request that the Examiner withdraw this rejection.

New Claims

Claims 2-19 are hereby added. Claims 2-10 are dependent from claim 1, recite various features of the invention, and are fully supported *at least* by FIG. 1 of the instant Application. Claim 11 is somewhat similar to claim 1, but recites only the features of the magneto-generator rotor of the invention. Claims 12-19 are dependent from claim 11, and are similar to claims 2-9.

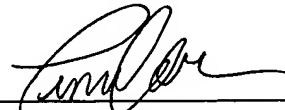
Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-19 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-19.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



Timothy P. Cremen
Registration No. 50,855

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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